In this Amendment applicant has amended claims 1-8, 11-18, 21-40, 43, and 45-52, and has added new claims 53-55. Claims have been amended and added to correct inadvertent errors, to present the claims more clearly, and to more particularly point out the invention. Support for the amendments and the new claims can be found on pages 6, 7, 9, 12-19, and 21-23, of the specification, and in the original claims. No new matter has been added. Claims 1-55 are now pending in the application.

1. Claim Rejections-35 U.S.C. 101

In the Office Action mailed 5/21/2004, the examiner states that "[c]laims 1-52 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter because the claimed methods and system broadly interpreted merely read on a human being carrying out the claimed invention with paper and pencil." Applicant submits that the examiner's statement that the claims "read on a human being carrying out the claimed invention with paper and pencil" is not a proper basis for rejecting the claims, and that there is no controlling legal authority for rejecting claims on this basis. The claims as originally filed, and as amended in this Amendment, are process and machine claims, which are statutory subject matter under 35 U.S.C. 101. *See*, AT&T Corp. v. Excel Communications, 172 F.3d 1352, 50 U.S.P.Q.2d 1447 (Fed. Cir. 1999), *cert. denied,* 528 U.S. 946 (1999). Thus, the applicant respectfully requests that the examiner remove this rejection. Further, applicant has amended claim 1 such that the preamble as amended recites "A computer based method ...", and applicant has amended claim 12 such that the preamble as amended recites "In a computing

system, a method ...", and applicant has amended claim 22 such that the preamble as amended recites "An apparatus ...", and applicant has amended claim 34 such that the preamble as amended recites "A computing system ...", and applicant has amended claim 45 such that the preamble as amended recites "A computer based method ...".

2. Claim Objections

In the Office Action, the examiner states that "claim 34 is objected to because of a likely typographical error at line 4, --rule-- has to be inserted after "the new". In this Amendment, the applicant has amended claim 34, so that in line 4, claim 34 now states "the new rule", as suggested by the examiner. Consequently, the applicant requests that the examiner remove this objection.

3. Claim Rejections-35 U.S.C. 112

In the Office Action, the examiner states that "[c]laims 6, 16, 40 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention because it is not clear what is being compared. Does applicant intend to mean comparing with the corresponding parameters of the new rule?" In this Amendment claims 6, 16, and 40 have been amended so that the wording referred to by the examiner has been deleted from the claims. Consequently, the applicant submits that claims 6, 16, and 40, as amended, are not indefinite, and applicant respectfully requests that the examiner remove this rejection.

4. Claim Rejections-35 U.S.C. 103

In the Office Action, the examiner states that "[c]laims 1-52 are rejected under 35 U.S.C. 103(a) as being unpatentable over Jolly (US 5,592,590), provided by the applicant." The applicant respectfully submits that all of the claims as amended in this Amendment are nonobvious in view of Jolly. In the following discussion, unless specified otherwise, the claims referred to are the claims as amended in this Amendment.

a. Legal Criteria

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art and not based on applicant's disclosure. *In re Vaeck,* 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).

MPEP § 706.02(j) (8th ed., rev. 2, 2004).

The mere fact that references <u>can</u> be combined or modified does not render the resultant combination obvious unless the prior art also

suggests the desirability of the combination. *In re Mills*, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990).

MPEP § 2143.01 (8th ed., rev. 2, 2004)(emphasis in original).

When applying 35 U.S.C. 103, the following tenets of patent law must be adhered to:

(A) The claimed invention must be considered as a whole;

(B) The references must be considered as a whole and must suggest the desirability and thus the obviousness of making the combination;

(C) The references must be viewed without the benefit of impermissible hindsight vision afforded by the claimed invention; and

(D) Reasonable expectation of success is the standard with which obviousness is determined.

Hodosh v. Block Drug Co., Inc., 786 F.2d 1136, 1143 n.5, 229 USPQ 182, 187 n.5 (Fed. Cir. 1986).

MPEP § 2141 (8th ed., rev. 2, 2004).

In determining the differences between the prior art and the claims, the question under 35 U.S.C. 103 is not whether the differences themselves would have been obvious, but whether the claimed invention as a whole would have been obvious. *Stratoflex, Inc. v. Aeroquip Corp.*, 713 F.2d

1530, 218 USPQ 871 (Fed. Cir. 1983); *Schenck v. Nortron Corp.*, 713

F.2d 782, 218 USPQ 698 (Fed. Cir. 1983).

MPEP § 2141.02 (8th ed., rev. 2, 2004).

b. Discussion

In section 4 of the Office Action, the examiner states that "[t]he claimed new rule

broadly interpreted is met by any of the rules one, two and three shown in Table 1 [of

Jolly]." Applicant respectfully submits that Table 1 of Jolly, and Jolly in general, do not

teach or suggest "receiving a new rule", and further, do not teach or suggest "receiving

a new rule having a timestamp parameter" as is recited in claims 1 and 55, or "receiving

a new rule having a plurality of parameters including a parameter that indicates whether

the new rule was added by an administrator" as is recited in claim 12, or "an entry

device for entering a new rule having a timestamp parameter, into the data

administration system" as is recited in claim 22, or "means for entering a new rule into

the data administration system, the new rule including at least one parameter" as is

recited in claim 34, or "entering a new rule into the data administration system, the new

rule including a plurality of parameters, wherein the plurality of parameters include a

timestamp parameter" as is recited in claim 45.

In section 4 of the Office Action, the examiner states, "[r]egarding claim 4, Jolly

discloses one parameter of the new rule defines a class of parameters when Jolly

shows 'Amount due', 'Num due' in Table 1." Applicant respectfully submits that

"Amount due" and Num due" in Table 1 of Jolly, and Jolly in general, do not teach or

suggest one parameter defining a class of parameters. Further, Jolly does not teach or suggest the following claim limitations. In claim 4: "the new rule encompasses the existing rule when the at least one additional parameter of the new rule defines a class of parameters that includes the corresponding parameter of the existing rule". In claim 14: "the at least one additional parameter of the new rule encompasses the corresponding parameter of the existing rule if the at least one additional parameter of the new rule defines a class of parameters that includes the corresponding parameter of the existing rule". In claim 26: "the at least one additional parameter of the new rule encompasses the corresponding parameter of the existing rule if the at least one additional parameter of the new rule defines a class of parameters that includes the corresponding parameter of the existing rule". In claim 36: "the at least one additional parameter of the new rule encompasses the corresponding parameter of the existing rule when the at least one additional parameter of the new rule defines a class of parameters that includes the parameter of the existing rule". In claim 47: "each of the parameters of the new rule encompasses the corresponding one of the plurality of parameters of the first existing rule when each of the parameters of the new rule defines a class of parameters that includes the corresponding one of the plurality of parameters of the first existing rule".

In section 4 of the Office Action, the examiner states, "[r]egarding claim 7, Jolly discloses determining precedence and comparing if the existing rule has precedence over the new rule when Jolly shows priority assignment (see column 1, lines 28-67)." In section 4 of the Office Action the examiner also states, "[r]egarding claim 8, although Jolly does not specifically show determining whether the existing rule precedes the new

rule in time, Jolly clearly shows that rules change often (see column 1, lines 35-38),

Therefore [sic], it would have been obvious to one of ordinary skill in the art to include

the claimed feature in order to eliminate expired rules." In this regard, applicant

respectfully submits that Jolly does not teach or suggest the claimed invention because

Jolly merely discloses, at column 1, lines 42-46, that "priorities are assigned to the rules

… [so that] only the only the highest priority rule that is applicable will execute." Further,

independent claims 1, 22, 34, and 55 include the following limitations, which are not

taught or suggested by Jolly:

"comparing the timestamp parameter of the new rule with a [or "the"] timestamp

parameter of an [or "the"] existing rule;

determining if the timestamp parameter of the new rule is later than the

timestamp parameter of the existing rule;

and if not so,

terminating comparing the new rule to the existing rule;

and if so,

comparing at least one additional parameter of the new rule

with a corresponding parameter of the existing rule in said data

administration system; and

([claim 1:] eliminating the existing rule if the new rule

encompasses the existing rule)

([claim 22:] eliminating the existing rule if the at least one

additional parameter of the new rule encompasses the

corresponding parameter of the existing rule)

([claims 34 and 55:] eliminating the existing rule if the new

rule encompasses the existing rule, wherein the new rule

encompasses the existing rule if the at least one additional

parameter of the new rule encompasses the corresponding

parameter of the existing rule)."

Similarly, claim 12 includes the following limitations that are not taught or suggested by
Jolly:

"receiving a new rule having a plurality of parameters including a parameter that

indicates whether the new rule was added by an administrator;

reading and storing the plurality of parameters of the new rule;

comparing the parameter that indicates whether the new rule was added by the

administrator, with a corresponding parameter of an existing rule;

determining if, both, the new rule was added by an administrator and the existing

rule was added by a subordinate;

and if not so,

terminating comparing the new rule to the existing rule;

and if so,

comparing at least one additional parameter of the new rule

with a corresponding parameter of an the existing rule in said data

administration system; and

eliminating the existing rule if the at least one additional

parameter of the new rule encompasses the corresponding

parameter of the existing rule."

Similarly, claim 45 includes the following limitations that are not taught or suggested by

Jolly:

"comparing the timestamp parameter of the new rule with a timestamp parameter

of a first existing rule having a plurality of parameters;

determining if the timestamp parameter of the new rule is later than the

timestamp parameter of the first existing rule;

and if not so,

terminating comparing the new rule;

and if so,

comparing each additional parameter of the new rule with a

corresponding parameter in the plurality of parameters of the first

existing rule in said data administration system;

eliminating the first existing rule if the new rule encompasses

the first existing rule, wherein the new rule encompasses the first

existing rule if each additional parameter of the new rule

encompasses the corresponding parameter of the first existing rule;

and

determining if the timestamp parameter of the new rule is

later than the timestamp parameter of a second existing rule;

and if not so,

      terminating comparing the new rule;

and if so,

      comparing each additional parameter of the new rule with a corresponding parameter of the second existing rule in said data administration system; and

      eliminating the second existing rule if the new rule encompasses the second existing rule, wherein the new rule encompasses the second existing rule if each additional parameter of the new rule encompasses the corresponding parameter of the second existing rule."

Because, as discussed above, the independent claims are novel and nonobvious, it follows that all of the dependent claims are also novel and nonobvious. Further, additional novel and nonobvious limitations are included in the dependent claims. Some examples are discussed as follows:

Similar to independent claim 1 discussed above, dependent claims 7, 24, and 38 include the following limitations that are not taught or suggested by Jolly:

"comparing the timestamp parameter of the new rule with a timestamp parameter of an additional existing rule;

determining if the timestamp parameter of the new rule is later than the

timestamp parameter of the additional existing rule;

and if not so,

terminating comparing the new rule to the additional existing

rule;

and if so,

([claim 7:] comparing each additional parameter of the new

rule with a corresponding parameter of the additional existing rule

in said data administration system; and

[claim 7:] eliminating the additional existing rule if each

additional parameter of the new rule encompasses a corresponding

parameter of the additional existing rule)

([claims 24 and 38:] comparing at least one additional

parameter of the new rule with a corresponding parameter of the

additional existing rule in said data administration system; and

eliminating the additional existing rule if the new rule

encompasses the additional existing rule)."

Similarly, dependent claim 18 includes the following limitations that are not taught

or suggested by Jolly:

"comparing the parameter that indicates whether the new rule was added by the

administrator, with a corresponding parameter of an additional existing rule;

determining if, both, the new rule was added by the administrator and the

additional existing rule was not added by the administrator;

and if not so,

terminating comparing the new rule to the additional existing rule;

and if so,

comparing at least one additional parameter of the new rule

with a corresponding parameter of the additional existing rule in

said data administration system; and

eliminating the additional existing rule if the at least one

additional parameter of the new rule encompasses the

corresponding parameter of the additional existing rule.

Additionally, dependent claims 6, 30, 40, and 48 include the following limitations

that are not taught or suggested by Jolly:

"logging an event indicating a database inconstancy if the timestamp parameter of the

new rule is not later than the timestamp parameter of the existing rule."

Similarly, dependent claim 16 includes the following limitations that are not taught or

suggested by Jolly:

"logging an event indicating a database inconsistency if the new rule was added by the

subordinate and the existing rule was added by the administrator."

Additionally, dependent claims 17 and 53 include the following limitations that are

not taught or suggested by Jolly:

"the new rule encompasses the existing rule if the at least one additional parameter of

the new rule has a wildcard character, and the at least one additional parameter of the

new rule having the wildcard character includes the corresponding parameter of the

existing rule."

Similarly, claim 54 includes the following limitations that are not taught or suggested by

Jolly:

"the at least one additional parameter of the new rule encompasses the corresponding

parameter of the existing rule if the at least one additional parameter of the new rule has

a wildcard character, and the at least one additional parameter of the new rule having

the wildcard character includes the corresponding parameter of the existing rule."

Additionally, dependent claims 8, 27 and 49 include the following limitations that

are not taught or suggested by Jolly:

"including a unique key with each timestamp parameter so the system can distinguish

between entries that occur at substantially the same time."

Similarly, claim 37 includes the following limitations that are not taught or suggested by

Jolly:

"a unique key is included with each timestamp parameter so the means for comparing

can distinguish between entries that occur at substantially the same time."

CONCLUSION

Applicant respectfully submits that all of the claims are directed to statutory

subject matter, are not indefinite, and are novel and nonobvious in view of the

references. Accordingly, applicant respectfully submits that the application is in condition for allowance, and applicant requests reconsideration and further examination, and allowance of the application. Any additional fees required in connection with this amendment which are not specifically provided for herewith are authorized to be charged to Deposit Account No. 09-0466 in the name of International Business Machines Corporation.

Respectfully submitted,

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